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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,252	07/24/2003	Edward B. Knudson	UV-34 Cont 3	4198
1473 7590 08/08/2007 FISH & NEAVE IP GROUP ROPES & GRAY LLP 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704				
			EXAMINER STOKELY-COLLINS, JASMINE N	
			ART UNIT 2609	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/627,252

Applicant(s)

KNUDSON ET AL.

Examiner

Jasmine Stokely-Collins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/24/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date ALL
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1-20 are objected to because of the following informalities:

Claim 1, lines 6 and 11, limitation "the television interactive program guide" should be changed to --said interactive television program guide--.

Claim 1, lines 8 and 14, limitation "the video recorder" should be changed to --said video recorder--.

Claim 1, line 9, limitation "the television" should be changed to --said television--.

Claim 1, line 14, limitation "the selected program" should be changed to --said selected program--.

Claim 1, line 14, second instance of limitation "the user" should be changed to --said user--.

Claim 2, line 3, "cancelling" should be changed to --canceling--.

Claim 2, limitation "the selected program" should be changed to --said selected program--.

Claim 2, limitation "the user" should be changed to --said user--.

Claim 2, limitation "the message" should be changed to --said message--.

Claim 3, lines 6 and 7, limitation "the selected program" should be changed to --said selected program--.

Claim 3, limitation "the video recorder" should be changed to --said video recorder--.

Claim 3, limitation "the user" should be changed to --said user--.

Claim 3, limitation "the message" should be changed to --said message--.

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Claim 4, limitation "the selected program" should be changed to --said selected program--.

Claim 4, limitation "the video recorder" should be changed to --said video recorder--.

Claim 4, limitation "the user" should be changed to --said user--.

Claim 4, limitation "the message" should be changed to --said message--.

Claim 5, lines 5 and 7, limitation "the selected program" should be changed to --said selected program--.

Claim 5, lines 6 and 7, limitation "the video recorder" should be changed to --said video recorder--.

Claim 5, limitation "the user" should be changed to --said user--.

Claim 5, limitation "the message" should be changed to --said message--.

Claim 6, line 7 and 12, limitation "the interactive television program guide" should be changed to --said interactive television program guide--.

Claim 6, lines 9 and 14, limitation "the video recorder" should be changed to --said video recorder--.

Claim 6, line 10, limitation "the television" should be changed to --said television--.

Claim 6, line 14, limitation "the selected program" should be changed to --said selected program--.

Claim 6, line 14, second instance of limitation "the user" should be changed to --said user--.

Claim 7, line 2, "cancelling" should be changed to --canceling--.

Claim 7, limitation "the selected program" should be changed to --said selected program--.

Claim 7, limitation "the user" should be changed to --said user--.

Claim 7, limitation "the message" should be changed to --said message--.

Claim 8, lines 5 and 6, limitation "the selected program" should be changed to --said selected program--.

Claim 8, limitation "the video recorder" should be changed to --said video recorder--.

Claim 8, limitation "the user" should be changed to --said user--.

Claim 8, limitation "the message" should be changed to --said message--.

Claim 9, limitation "the selected program" should be changed to --said selected program--.

Claim 9, limitation "the video recorder" should be changed to --said video recorder--.

Claim 9, limitation "the user" should be changed to --said user--.

Claim 9, limitation "the message" should be changed to --said message--.

Claim 10, lines 5 and 7, limitation "the selected program" should be changed to --said selected program--.

Claim 10, lines 6 and 7, limitation "the video recorder" should be changed to --said video recorder--.

Claim 10, limitation "the user" should be changed to --said user--.

Claim 10, limitation "the message" should be changed to --said message--.

Claim 11, lines 7 and 11, limitation "the television interactive program guide" should be changed to --said interactive television program guide--.

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Claim 11, lines 9 and 15, limitation "the video recorder" should be changed to --said video recorder--.

Claim 11, line 9, limitation "the television" should be changed to --said television--.

Claim 11, line 14, limitation "the selected program" should be changed to --said selected program--.

Claim 11, line 16, second instance of limitation "the user" should be changed to --said user--.

Claim 12, limitation "the selected program" should be changed to --said selected program--.

Claim 12, limitation "the user" should be changed to --said user--.

Claim 12, limitation "the message" should be changed to --said message--.

Claim 13, lines 6 and 7, limitation "the selected program" should be changed to --said selected program--.

Claim 13, limitation "the video recorder" should be changed to --said video recorder--.

Claim 13, limitation "the user" should be changed to --said user--.

Claim 13, limitation "the message" should be changed to --said message--.

Claim 14, limitation "the selected program" should be changed to --said selected program--.

Claim 14, limitation "the video recorder" should be changed to --said video recorder--.

Claim 14, limitation "the user" should be changed to --said user--.

Claim 14, limitation "the message" should be changed to --said message--.

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Claim 15, lines 6 and 8, limitation "the selected program" should be changed to --said selected program--.

Claim 15, lines 6 and 7, limitation "the video recorder" should be changed to --said video recorder--.

Claim 15, limitation "the user" should be changed to --said user--.

Claim 15, limitation "the message" should be changed to --said message--.

Claim 16, lines 5 and 10, limitation "the television interactive program guide" should be changed to --said interactive television program guide--.

Claim 16, lines 7 and 13, limitation "the video recorder" should be changed to --said video recorder--.

Claim 16, line 8, limitation "the television" should be changed to --said television--.

Claim 16, line 13, limitation "the selected program" should be changed to --said selected program--.

Claim 16, line 14, second instance of limitation "the user" should be changed to --said user--.

Claim 17, line 3, "cancelling" should be changed to --canceling--.

Claim 17, limitation "the selected program" should be changed to --said selected program--.

Claim 17, limitation "the user" should be changed to --said user--.

Claim 17, limitation "the message" should be changed to --said message--.

Claim 18, lines 4 and 5, limitation "the selected program" should be changed to --said selected program--.

Claim 18, limitation "the video recorder" should be changed to --said video recorder--.

Claim 18, limitation "the user" should be changed to --said user--.

Claim 18, limitation "the message" should be changed to --said message--.

Claim 19, limitation "the selected program" should be changed to --said selected program--.

Claim 19, limitation "the video recorder" should be changed to --said video recorder--.

Claim 19, limitation "the user" should be changed to --said user--.

Claim 19, limitation "the message" should be changed to --said message--.

Claim 20, lines 4 and 6, limitation "the selected program" should be changed to --said selected program--.

Claim 20, lines 4 and 5, limitation "the video recorder" should be changed to --said video recorder--.

Claim 20, limitation "the user" should be changed to --said user--.

Claim 20, limitation "the message" should be changed to --said message--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16-20 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 16-20 claim a computer-readable medium embodying functional descriptive material. However, the claim does not define a computer-readable medium



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to be a memory/disk and is thus non-statutory for that reason (i.e. "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized").

However, the specification (at page 9, section 0034...) indicates – "other forms of propagated signals (e.g. carrier waves, infrared signals, digital signals, etc.) that data may be formatted (stored within the communication/transport medium, i.e. signal) for broadcasting. Therefore, the specification defines the computer-readable medium to be a signal.

A "signal" embodying functional descriptive material is neither a process ("actions"), nor machine, nor manufacture, nor composition of matter (i.e. a tangible "thing") and therefore does not fall within one of the four statutory categories of § 101. Rather, "signal" is a form of energy, in the absence of any physical structure or tangible material.

Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory, under the present USPTO Interim Guidelines, 1300 Official Gazette Patent and Trademark Office 142 (Nov. 22, 2005).

***Claim Rejections - 35 USC § 103***

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2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5-8, 10-13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al (US 5,353,121) in view of Michaud (US 6,057,874).

Regarding claim 1, Young teaches an interactive program guide system (figures 22a, 22b) including user equipment (figure 22a) with which an interactive television program guide (figure 14) is provided and which includes a video recorder (figure 22a element 206) and a television (figure 22a element 210), comprising:

means for receiving television program guide information for use in the interactive television program guide (figure 22a);

means for selecting a program for recording from the interactive television program guide (figures 2 and 3, column 8 lines 19-22); and

means for displaying a message prior to recording the selected program when the video recorder and television are a combined unit (figure 22a, VCR and TV are physically connected via line 250 to form a TV/VCR unit) that informs the user that recording is to begin and asks the user whether to continue with recording (figure 12).

Young does not teach means for determining whether the video recorder and television are a combined unit.

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Michaud teaches means for determining whether the video recorder and television are a combined unit (column 4 lines 49-63). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the VCR model detection means of Michaud with the teachings of Young in order to ensure the use of proper control commands when recording on a VCR device.

Regarding claim 2, when read in light of claim 1, Young further teaches means for canceling the recording of the selected program when the user chooses to not continue with recording in response to the message (figure 12).

Regarding claim 3, when read in light of claim 1, Young further teaches means for receiving a plurality of television channels (column 18 lines 36-38); and means for tuning to the channel for the selected program and directing the video recorder to record the selected program when the user chooses to continue with recording in response to the message (column 19 lines 1-11).

Regarding claim 5, when read in light of claim 1, Young further teaches means for receiving a plurality of television channels (figure 22a element 202 PROGRAMMABLE TV TUNER AND CABLE DECODER); means for tuning to the channel for the selected program, turning on the video recorder, and directing the video recorder to record the selected program when the user does not respond to the message (column 19 lines 5-11).

Regarding claim 6, see analysis of claim 1.

Regarding claim 7, see analysis of claim 2.

Regarding claim 8, see analysis of claim 3.

Regarding claim 10, see analysis of claim 5.

Regarding claim 11, see analysis of claim 1. The claimed circuitry configured to perform the functions of claim 1 is inherent.

Regarding claim 12, see analysis of claim 2.

Regarding claim 13, see analysis of claim 3.

Regarding claim 15, see analysis of claim 5.

4. Claims 4, 9, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al (US 5,353,121) in view of Michaud (US 6,057,874), and further in view of Roop et al (US 5,619,274).

Regarding claim 4, Young and Michaud teach the system of claim 3.

Neither Young, nor Michaud explicitly discloses teaches means for recording the selected program without directing the video recorder to turn on when the user chooses to continue with recording in response to the message.

Roop further teaches means for recording the selected program without directing the video recorder to turn on when the user chooses to continue with recording in response to the message (column 15, lines 36-48). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Roop with those of Young and Michaud in order to modify the recording process for when the user is present during recording.

Regarding claim 9, see analysis of claim 4.

Regarding claim 14, see analysis of claim 4.

5. Claims 16-18, 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al (US 5,353,121) in view of Michaud (US 6,057,874), and further in view of Klosterman et al (US 6,078,348).

Regarding claim 16, Young and Michaud teach receiving television program guide information for use in an interactive television program guide;  
determining whether a video recorder and a television are a combined unit;  
providing a user with an opportunity to select a program for recording from the

interactive television program guide; and

displaying a message prior to recording the selected program when the video recorder and television are a combined unit that informs the user that recording is to begin and asks the user whether to continue with recording (see analysis of claim 1).

Young and Michaud do not teach a machine-readable medium for implementing an interactive television program guide comprising machine program logic recorded thereon.

Klosterman teaches using machine program logic (record daemon) for managing recording functions (column 9 lines 58-59). Such logic must inherently be recorded on some type of machine-readable medium. It would have been obvious to one of ordinary skill at the time the invention was made to combine the method of using programming to carry out recording functions stored on a machine readable medium taught by Klosterman with the recording functions of the present invention for the benefit of implementing those recording functions.

Regarding claim 17, when read in light of claim 16, please see analysis of claim 2.

Regarding claim 18, when read in light of claim 16, please see analysis of claim 3.

Regarding claim 20, when read in light of claim 16, see analysis of claim 5.

6. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al (US 5,353,121) in view of Michaud (US 6,057,874) and Roop et al (US 5,619,274), and further in view of Klosterman et al (US 6,078,348).

Young, Michaud, and Klosterman teach the machine-readable medium of claim 18.

Young, Michaud, and Klosterman do not teach directing the video recorder to record the selected program without directing the video recorder to turn on when the user chooses to continue with recording in response to the message.

Roop further teaches directing the video recorder to record the selected program without directing the video recorder to turn on when the user chooses to continue with recording in response to the message (column 15, lines 36-48). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Roop with those of Young, Michaud, and Klosterman in order to modify the recording process for when the user is present during recording.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Levine (US 5,692,214 A) teaches unattended video recording.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasmine Stokely-Collins whose telephone number is

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571-270-3459. The examiner can normally be reached on M-F 7:30-5:00 EST

\*\*\*Alternate Fridays off\*\*\*.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hai Tran can be reached on 571-272-7305. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jasmine Stokely-Collins



**HAI TRAN**  
**PRIMARY EXAMINER**